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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,010	02/05/2004	John L. Baugh	D5407-199	5333
25397	7590	11/16/2005		
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027			EXAMINER BOMAR, THOMAS S	
			ART UNIT 3672	PAPER NUMBER

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,010

Applicant(s)

BAUGH ET AL.

Examiner

Shane Bomar

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/5/04, 7/19/04
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Drawings***

1. The drawings are objected to because a) there are lead lines with no reference numbers or words, b) the numbers are handwritten, c) the section views have no cross-hatching, making it difficult to distinguish aspects of the drawings, d) in comparing Fig. 1 to Figs. 2, 5, and 6, it appears as though the opening 38 slides up along slope 52 with the swage, although 38 is supposed to be part of swage anchor 32, and e) Figs. 8-11 are too dark. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. In light of the numerous drawing objections shown above, the Examiner has examined the case to the best of his ability, but has had to make assumptions as to various aspects of the

Art Unit: 3672

invention. As one example, I cannot determine what exactly holds elements 44 and 46 in opening 38. The figures appear to simply show 44 and 46 wedged between swage anchor 32 and elements that are duplicates of 44 and 46. The specification states that 38 is a t-shaped opening, but the figures do not seem to properly convey this arrangement, especially since element 38 seems to slide along slope 52 along with 44 and 46.

### *Specification*

3. The disclosure is objected to because of the following informalities: at the end of paragraph [0023], it is stated that the swage anchor 32 has a beveled lower end 52, although Fig. 1 appears to suggest that the piston 24 is beveled; in the first line of paragraph [0025], the recitation of "Figure 11" should most likely be --Figure 1--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for moving segments toward a maximum diameter, does not reasonably provide enablement for preventing the movement of the segments in a reversed direction by a ratchet. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention

Art Unit: 3672

commensurate in scope with these claims. The specification is silent regarding, and the drawings do not appear to show, a ratchet that can perform the claimed function. Claim 24 depends from claim 23, and is also rejected.

### ***Claim Objections***

6. Claims 6 and 12 are objected to because of the following informalities: the recitation of "a potion" in claim 6 should most likely be --a portion--; the recitation of "in other location" in claim 12, should most likely be --in other locations--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 3,191,677 to Kinley.

Regarding claim 1, Kinley discloses an adjustable swage for use on a downhole tubular, comprising: a rounded body 29, 35, or 39 mounted to a mandrel 28 wherein said body is movable into a plurality of positions to create a variety of profiles (i.e., larger or smaller) effective for a full 360 degrees about said mandrel (see Figs. 1 and 4-12, and col. 3, lines 9-60).

Art Unit: 3672

Regarding claim 2, said profiles are circular and/or non-circular, depending on the profile chosen. For example, expanders 29 and 35 have circular profiles looking from the top or the side (see Figs. 4-8), whereas expander 38 has a circular top profile and a non-circular side profile (see Fig. 9).

9. Claims 1, 2, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,622,789 to Braddick.

Regarding claim 1, Braddick discloses an adjustable swage for use on a downhole tubular, comprising: a rounded body 120/120A mounted to a mandrel 108 wherein said body is movable into a plurality of positions to create a variety of profiles (i.e., larger or smaller) effective for a full 360 degrees about said mandrel (see Figs. 1H, 1J, 2D, and 4A, wherein, even in the smallest configuration of Fig. 2D, the elements 120 and 120A extend a full 360 degrees around the mandrel since the fingers 118 have the same width as the ends).

Regarding claim 2, said profiles are circular and/or non-circular, depending on the profile chosen. For example, the top profile is circular (see Fig. 1J), whereas the side profile is non-circular (see Fig. 2D and 4A).

Regarding claim 13, said body is formed of a plurality of abutting segments 120, 120A, 116, and 118 movable with respect to each other (see Figs. 1H, 1J, 2D, and 4A).

Regarding claims 14-16, said segments each comprise a high location 120 or 120A and at least some of said segments are movable to selectively align said high locations to obtain a maximum diameter or to offset them to attain a minimum diameter, wherein mandrel has a longitudinal axis and said segments slide relatively to each other in the direction of said

Art Unit: 3672

longitudinal axis, and further wherein said segments are retained to each other via a pin 115

while moving relatively to each other in a longitudinal direction (see Figs. 1H, 1J, 2D, and 4A).

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No.

2003/0155118 to Sonnier et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because, at the time the invention was made, it would have been obvious to one of ordinary skill in the art that the phrase “variety of profiles effective for a full 360 degrees” is encompassed by, and an obvious variant of, the phrase “variety of continuous circumferences for a full 360 degrees”.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3672


*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Abercrombie Simpson et al, Kelly, Kenning, Kinley et al, Langstaff, Simpson, Sizer et al, and Wimmer et al teach various tubing expanders of particular interest.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David J. Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

tsb   
November 9, 2005